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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,364	10/24/2003	Keith G. Lintott	10451.0054.NPUS01	3128

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EXAMINER

HWU, JUNE

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/693,364	LINTOTT, KEITH G.	
	<b>Examiner</b>	<b>Art Unit</b>	
	June Hwu	1661	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/1/04</u>  | 6) <input checked="" type="checkbox"/> Other: <u>Rule 105 requirement</u> . |

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### DETAILED ACTION

The amendment and declaration filed on July 1, 2004 have been acknowledged.

The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office action.

Requirement for Information follows regarding specifics of a potential offer for sale.

#### ***Rule 105 Requirements for Information***

An issue of public use or on sale activity has been raised in this application. Applicant should give evidence why the Garden Mum Catalog 2002 distributed on October 17, 2001 was not an offer for sale. Applicant should also indicate whether the claimed plant was ready for patenting, i.e. reduced to practice as in the instant plant had been asexually propagated and existed in its present form, more than one year prior to the effective filing date of this instant application (see MPEP 2133.03(c) I). The MPEP 2133.03 states:

The Invention Must Be "Ready for Patenting" at the Time of the Sale In *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 66-68, 119 S.Ct. 304, 311-12, 48 USPQ2d 1641, 1647 (1998), the Supreme Court enunciated a two-prong test for determining whether an invention was "on sale" within the meaning of 35 U.S.C. 102(b) even if it has not yet been reduced to practice. "[T]he on-sale bar applies when two conditions are satisfied before the critical date [more than one year before the effective filing date of the U.S. application]. First, the product must be the subject of a commercial offer for sale.... Second, the invention must be ready for patenting." *Id.* at 67, 119 S.Ct. at 311-12, 48 USPQ2d at 1646-47. "Ready for patenting," the second prong of the *Pfaff* test, "may be satisfied in at least two ways: by proof of reduction to practice before the critical date; or by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention." *Id.* at 67, 119 S.Ct. at 311-12, 48 USPQ2d at 1647 (The patent was held invalid because the invention for a computer chip socket was "ready for patenting" when it was offered for sale more than one year prior to the application filing date. Even though the invention had not yet been reduced to practice, the manufacturer was able to produce the claimed computer chip sockets using the inventor's detailed drawings and specifications, and those sockets contained all elements of invention claimed in the patent.). See also *Weatherchem Corp. v. J.L. Clark Inc.*, 163 F.3d 1326, 1333, 49 USPQ2d 1001, 1006-07 (Fed. Cir. 1998) (The invention was held "ready for patenting" since the detailed drawings of plastic dispensing caps offered for sale "contained each limitation of the claims and were sufficiently specific to enable person skilled in art to practice the invention"). If the invention was actually reduced to practice before being sold or offered for sale more than 1 year before filing of the application, a patent will be barred.

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In addition, Applicant should clearly and in depth set forth how this catalog listing is merely an advertisement (page 2 of IDS filed on July 1, 2004) especially since a call to Royal Van Zanten or Ball Seed Company would reveal pricing information of the plant (Gardenmum Catalog 2002, page 16).

In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows:

1. The relationship between Royal Van Zanten, Cleangro Ltd, and Ball Seed Company. It is not clear whether Royal Van Zanten controls Ball Seed Company. In addition, it is uncertain if Ball Seed Company buys or merely distributes the claimed invention.
2. It appears the catalog constitutes an offer for sale to Ball Seed Company because the catalog was presented at a conference on October 17, 2001 (disclosed in the Information Disclosure Statement (IDS) filed July 1, 2004, page 2 and the Hesse declaration, page 1). Also, Applicant states that the catalogs did not include any pricing information and if that information is needed that the potential customers may contact Ball Seed or Royal Van Zanten for prices (page 3 of IDS, page 2 of the Hesse declaration and Gardenmum Catalog 2002, page 16).
3. It is uncertain if the sales representatives of Ball Seed Company at the conference in Chicago on October 17, 2001 were able to place orders of the claimed plant more than one year prior to the effective filing date of the instant application.
4. In the IDS on page 2 and the Hesse declaration on page 1, they state that Royal Van Zanten sold its varieties to "select few customers directly". It is unclear if the claimed plant was for sale more than one year prior to the effective filing date of this instant application.
5. It is unclear if the catalog represented an offer for sale. It is also unclear whether any order for the plant were received prior to October 24, 2001 and whether any acceptance of any offer was made.

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This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

In order to consider whether a 102(b) rejection should be applied, the Examiner is requesting information pertaining to the claimed cultivar.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

#### ***Claim Rejections - 35 USC § 112***

Claim 1 remains rejected under 35 USC 112, first and second paragraphs because the claim is drawn to the plant as shown and illustrated. There is no photograph of 'Nighthawk Yellow'.

#### ***Drawing***

The disclosure is objected to under 37 CFR 1.165(a) because the present photograph in this application is a photograph of copending application serial number 10/693,365, *Chrysanthemum* 'Dove Bronze'. A replacement photograph is required.

#### ***Conclusion***

No claim is allowed.

#### **Future Correspondence**

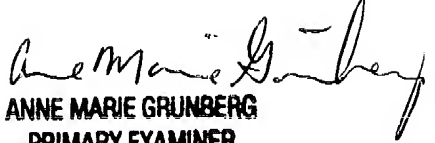
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH

  
ANNE MARIE GRUNBERG  
PRIMARY EXAMINER

**REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105**

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the information listed on page 3 of this Office Action that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to clearly explain if the claimed plant was offered for sale prior to the effective filing date of the instant application.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.